APPELLANT'S BRIEF AND APPENDIX

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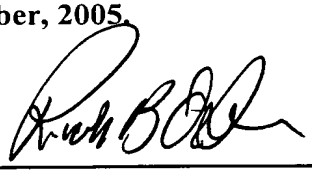

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	Confirmation No.: 6824
John Michael Fenkanyn	)	Docket No.: DN2003130
For: TIRE SENSOR INSERTION TOOL	)	Art Unit: 2856
AND METHOD	)	Examiner: Nashmiya Saqib Fayyaz
Serial No.: 10/639,672	)	
Filed: August 12, 2003	)	**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCE**

Board of Patent Appeals and Interferences
United States Patent and Trademark Office
P. O. Box 1450
Alexandria, Virginia 22313-1450

APPELLANT'S BRIEF

Dear Sir:

Appellant, by virtue of his Notice of Appeal filed September 14, 2005, hereby files his Brief in response to the Final Rejection of all pending claims in the above-identified application. Please charge my Deposit Account No. 07-1725 in the amount of Five Hundred and 00/100 Dollars ($500.00) to cover the fee for filing this Brief in support of this Appeal. Any deficiency or overpayment should be charged to this Deposit Account.

Real Party in Interest

By virtue of an Assignment dated August 8, 2003, by the named inventors, the real party in interest is The Goodyear Tire & Rubber Company. The August 8, 2003, Assignment has not been recorded in the U.S. Patent and Trademark Office.

Related Appeals and Interferences

There are no related appeals or interferences.

Status Of The Claims

Claims 1 through 13 are pending in the application. Claims 1 through 13 stand rejected.

Status Of Amendments

There are no outstanding amendments. A response after final was filed September 14, 2005 following Final Rejection of the application.

Summary of the Invention

The subject invention as claimed comprises a novel tool that provides a convenient, accurate, and safe means for the insertion and release of a sensor to a predetermined depth within a bore. The tool provides a construction that allows the leads from the sensor to be routed the axial length of the tool. As the tool pushes a sensor to a predetermined depth within the bore, the tip of the tool slides along the sensor leads that reside within the tip axial bore. Once the sensor is to the predetermined depth, the tip is withdrawn, again, sliding along the sensor leads within the tip axial bore. The socket at the forward end of the tool is configured to push the sensor to the desired depth and release the sensor as the tip is withdrawn. A window is further provided through which a marking on the sensor leads can be visually detected as the tip inserts the sensor. The mark on the sensor leads is placed at a preset distance from the sensor. The tip of the tool is substantially the length of the bore. A user will detect the marking on the sensor leads through the window just prior to the tool tip bottoming out in the bore and thereby avoid impacting the sensor at the tip end against the bottom of the bore. The tool thus provides a device for safely *pushing* a sensor to a desired depth; *avoiding impact* of the sensor with the bottom of the bore; and *releasing* the sensor at the desired depth by the withdrawal of the tip from the bore.

With specific reference to the claim language, the tool comprises an elongate tool tip affixed to a handle, the tip having an extending to a remote tip end. The tip end has a sensor receiving axial passageway socket in communication with the tip axial passageway, the socket being configured to push the sensor into the bore to the predetermined depth and release the sensor at the predetermined depth as the remote tip socket is withdrawn from the bore

(independent claims 1, 10 and claims dependent therefrom). The handle includes an axial passageway in axial alignment with the tip axial passageway for receiving sensor leads through the aligned passageways (claim 2). The tip is detachable (claim 3) and the handle includes a T-shaped gripping portion (claim 4). An observation window is spaced a predetermined distance from the remote tip end, the window having a transverse orientation with the axial passageway and positioned to allow visual communication with the tip passageway and sensor leads disposed from the sensor along the tip axial passageway (claims 5 and 11). Pushing of the sensor to an accurate depth in the bore is thus facilitated. The tip further includes an axial slit in communication with the axial passageway (claims 6, 13) and the tip is sized substantially equal to the depth of the bore (claims 7, 12).

Issues

I. Are claims 1, 3, 4, and 7 through 10 anticipated by Waterman, U.S. Patent No. 5,770,809 under 35 U.S.C. Section 102(b).

II. Are claims 2, 5, 6, and 11 through 13 obvious over Waterman ('809) in view of Waterman (U.S. Patent No. 4,537,071).

III. Are claims 1 through 13 in compliance with the enabling requirement of 35 U.S.C. Section 112, first paragraph.

ARGUMENT

I. Claims 1, 3, 4, and 7 through 10 are not anticipated by Waterman, U.S. Patent No. 5,770,809 under 35 U.S.C. Section 102(b).

To be a proper basis for a rejection of the claims under 35 U.S.C. Section 102(b), the reference must show each and every limitation in the rejected claims. Waterman fails to teach each limitation found in claims 1, 3, 4 and 7 through 10 as required to support a rejection under 35 U.S.C. Section 102(b). The Examiner has misapplied Waterman based upon a misunderstanding of the reference structure and has not provided, in support of the rejection, an explanation of how the reference meets each limitation found in the claims.

Specifically, Waterman is directed to a tool that fixedly *attaches to a probe, inserts the*

probe into a pressure vessel, unlocks the probe, and then is withdrawn. The tool does not project into a bore and does not release the probe as a tip is withdrawn from the bore. (emphasis added). Waterman's probe consists of a drive piston that forces the probe end into a pressurized vessel against internal pressure of the vessel and removes the probe by a reverse procedure when the measurement, or sensor function is complete.

In contrast, as specifically claimed in claims 1, 3, 4, and 7 through 10, the subject invention is to a socket at the end of a tip body that pushes *and then releases* a sensor *as* the remote tip socket is withdrawn. Claim 1 specifically recites a release of the sensor at a depth within a bore as the socket at the remote tip end is withdrawn from a bore. No where does Waterman teach a socket at a remote tool tip end configured to *release a sensor as the tip end is withdrawn from a bore* and the Examiner has provided no application of Waterman on this claim limitation.

Moreover, independent claims 1 and 10 recite an axial passageway extending to a remote tip end and a socket at the remote tip end in communication with the axial passageway. Such a configuration allows sensor leads to travel from the sensor at the tip end through the tool to exit from the opposite tip end. The Examiner considers Waterman body 71 to represent a tip body and Waterman cylinder 91 to be an axial passageway. Yet it is clear that no communication is present between a socket at the forward end of body 71 and cylinder 91 such that leads from a sensor at a forward end of body 71 may be routed through the body 71 along an axial bore. Moreover, the claims of the subject invention are to a tip body and socket (at the end of the tip body) that push a sensor to a prescribed depth within a bore. No part of body 71, much less a socket at a remote end, in Waterman projects into a bore (and/or is withdrawn from the bore as recited in the claims) and certainly the length of body 71 is not taught in Waterman to correlate substantially with the depth of a bore. Waterman inserts probe 20 by means of the stroke of piston 92, to the contrary. In short, no portion of Waterman body 71

constitutes a socket for pushing a sensor into a bore. No portion of Waterman body 71 projects into a bore, or is withdrawn from a bore. Waterman body 71 thus fails to meet the limitations as to the tool tip as defined in the claims.

While unclear from the relevant Office Actions, the Examiner alternatively appears to consider the probe 20 to be a tool tip that renders the rejected claims anticipated. Note that the probe 20 does not project into a bore, does not push a sensor to a depth within a bore, and does not release a sensor as the probe 20 is withdrawn from a bore. Therefore, as with body 71, probe 20 fails to meet the claim limitations and cannot be a proper basis for rejection of the claims under 35 U.S.C. 102. Moreover, to meet the claim limitations for the tool tip, probe 20 would need to teach an axial passageway to a remote tip end; a sensor receiving socket at a remote tip end communicating with the tip axial passageway; and the socket having a configuration to push the sensor into the bore and leave the sensor within the bore upon withdrawal of the end of probe 20 from a bore. (Claims 1, 10). Probe 20 lacks all such structure. Moreover, there is no socket taught as attached to a remote end of probe 20 for pushing a sensor into a bore or releasing the sensor as the end of probe 20 is withdrawn from a bore. In short, neither probe 20 or body 71 of Waterman push a sensor to a predetermined depth within a bore or release a sensor upon removal of a remote end of the probe 20 or body 71 from a bore.

The only structure of Waterman that may be fairly considered to push probe 20 into the container vessel is the threaded socket 117 of piston 92. Yet socket 117 is not configured to be in communication with an axial tip passageway. The socket 117 is solid (see FIG. 2) and does not communicate with cylinder 91, even assuming that cylinder 91 could be deemed to constitute the axial passageway of a tool tip (which interpretation Applicant traverses). The claims also specify the sensor engaging socket to be at the remote tip end. Socket 117 is not at the remote end of body 71. The socket 85, however, cannot meet the limitations of a socket at

a remote end of a tip member because socket 85 receives the probe 20 therethrough and is not at the remote end of probe 20. Moreover, socket 85 in Waterman '809 does not communicate with cylinder 91 because of the obstruction represented by piston 92. Socket 85 attaches to the piston 92 and is blocked thereby from communication with the cylinder 91. Still further, socket 85 does not release a sensor at a predetermined depth *as* (i.e. simultaneously) the tip socket is withdrawn form the bore. In short, socket 85 does not perform the dual functions of pushing and releasing probe 20; does not communicate with the cylinder 91; and does not release a sensor as it is withdrawn from a bore, and, in fact, is never withdrawn from any bore. The Examiner has stated that socket 85 is "for receiving the probe 20 where the probe is pushed into the bore and released". However, the claims require the socket to push and release the sensor *as the socket is withdrawn from a bore.* Waterman socket 85 does not push against an end of probe 20. The specification portion Column 3, Lines 41 et. seq., referenced in the Office Action, cannot be relied upon as teaching that socket 85 pushes and releases probe 20 upon withdrawal of the socket 85 from a bore for socket 85 is never withdrawn from a bore (emphasis added). No support in Waterman, accordingly, can be fairly relied upon in anticipating the claims of the pending application.

As to claim 3, Waterman teaches a fixed connection between its handle and the remaining apparatus. No teaching as to the need or benefit to removing the Waterman handle is found in the reference. The Examiner's conclusion that the body 71 is detachable from the Waterman handle is, therefore, considered erroneous.

As to claims 4 and 8, the Waterman handle 97 is not seen as forming a T-shaped gripping portion as required in the claims. The gripping portion of Waterman handle 97 appears to project as a straight cylinder from body 71. The rejection is accordingly traversed.

As to claim 7, it is not clear what bore and tip structure in Waterman the Examiner is comparing to the claimed invention. Body 71 is certainly not substantially the same length as

the wall through which probe 20 extends. Body 71 does not even extend through the container wall. Body 71, therefore, cannot meet the limitation of the claims to a tool tip that pushes a sensor at a forward tip end to a depth within a bore, much less to a tip that is of substantially the same length as the bore.

As to claim 9, Waterman does not configure body 71 as a roll pin. No anticipation of claim 9 is therefore possible from Waterman.

For the reasons above, Waterman fails to teach every limitation found in the claims. The Examiner has relied on certain Waterman structure for teaching the claimed invention when such structure does not meet all of the limitations required in the claim language.

In the advisory action mailed October 7, 2005, the Examiner takes the position that the claims do not call for projecting the tool into a bore. Such a position is literally and conceptually illogical. Applicant respectfully disagrees. The claims recite a tool tip end that is configured to push the sensor into a bore to a predetermined depth. If an end of a tip pushes an object to a depth within a bore, logically the end of the tip extends into the bore to an extent just slightly less than the target depth. Such a limitation therefore does call for projecting the tool (i.e. the tip end) into a bore. The Examiner's position that withdrawal of the tip socket from a bore after pushing a sensor to a predetermined depth within the bore does not demand that the tip socket ever be inside the bore is likewise untenable, illogical, and contrary to the literal language of the claims. Such an interpretation goes against the common meaning of the claim language. An object cannot be withdrawn from a bore without first having been present in the bore.

The Examiner in the Advisory Action takes the position that the projection of Waterman probe 20 through a wall of pressurized container vessel 64 anticipates the claimed tool tip. However, for probe 20 to be a tool tip as defined in the claims, probe 20 must have an axial passageway to a remote tip end (lacking in probe 20); a sensor receiving socket at a

remote tip end communicating with the tip axial passageway (again, lacking in probe 20); and a socket at a remote end configured to push against a sensor (also lacking in the probe 20). Probe 20 would further need to release a sensor within a bore upon withdrawal of a remote end of the probe 20 from a bore. (Claims 1, 10). Probe 20 in Waterman '809 lacks all such claimed structure.

The Waterman '809 reference teaches no socket "configured to push a sensor into a bore to a predetermined depth and release the sensor at the predetermined depth as the remote tip socket is withdrawn from the bore. As explained above, no socket is used by Waterman configured to both push and release a sensor, upon removal of the socket from a bore. Socket 85 in Waterman does not push and release. The Examiner has not identified what exactly is the "bore" in Waterman. If it is the wall of the container, the Waterman probe 20 extends past the Waterman "bore" (container wall) and is not released at a predetermined depth. And, because the Waterman socket 85 never enters into the opening through the Waterman '809 container wall, it can hardly be argued that socket 85 releases probe 20 at a depth within the wall as the socket 85 is withdrawn from within the wall. For the Waterman socket 85 to read on the tip structure of claims 1 and 10, it must at some point be withdrawn from a bore. The Examiner has presented no plausible teaching from Waterman to meet such claim limitations.

To summarize, Applicant submits that because a socket at a remote tip end pushes a sensor to predetermined depth within a bore and is subsequently withdrawn from the bore, it must necessarily have entered into the bore. To the contrary, the Examiner contends a withdrawal of the remote tip socket from a bore can be accomplished without the remote tip socket ever being within the bore.

Moreover, Applicant submits that the Examiner's position that the claims do not require an unobstructed passageway formed by a socket is traversed. Claims 1 and 10 define a socket in communication with the tip axial passageway. A socket, according to Webster's

New Collegiate Dictionary, 1977 edition, defines "socket" as "an opening or hollow that forms a holder for something". Therefore, a socket in communication with the tip axial passageway is an opening in communication with a passageway. The meaning of the claimed language is clear from its consistent usage in the specification and the drawings. The clear language of the claims, therefore, means there is a pathway through the socket to an axial passageway of the tool tip. No such passageway is found between element 85 and any structure that can meet the limitations to a tool tip set forth in the claims. The Examiner has not applied the Waterman socket 85 to the specific language in the claims 1 and 7. Such claims require: a socket at a remote end of a tool tip; a communication between that socket and an axial passageway through the tool tip. Socket 85 is connected to a piston 92 and piston 92 blocks any communication of the socket 85 with the piston cylinder.

As to the rejection of claim 7, the Examiner has not identified with clarity what structure in Waterman '809 is deemed to be the claimed "tool tip" or what constitutes a "bore" in the Waterman disclosure. Claim 7 recites a tool tip having a length substantially equal the depth of the bore. The Examiner has not identified a "bore" in Waterman or any structure that can be construed as a tool tip having a length equal to that bore.

In summary, the Examiner relies on an element 85 for teaching a socket as claimed, but socket 85 is never withdrawn from a bore to release a sensor at a predetermined depth within that bore. Nor is the socket 85 in Waterman '809 attached to a tool tip remote end and in communication with an axial tool tip passageway. The socket 85 is never withdrawn from a bore and, being connected to piston 92, is obstructed from any communication with the piston cylinder. In addition, for the reasons above, the socket 85 of Waterman '809 does not push a sensor to a predetermined depth within a bore and release a sensor at the depth as the socket 85 is withdrawn from the bore. Waterman '809 fails to meet every limitation within the rejected claims and the rejection is therefore considered improper under 35 U.S.C. Section 102.

II. Claims 2, 5, 6, and 11 through 13 are not obvious from Waterman ('809) in view of Waterman (U.S. Patent No. 4,537,071).

To establish *prima facie* obviousness, there (1) must be some suggestion or motivation in the art to modify or combine the references; (2) must be a reasonable expectation of success and (3) the combined references must teach or suggest all the claim limitations. Here, the Examiner has pointed to no suggestion or motivation in the art to modify or combine the Waterman references. Moreover, the combined Waterman references do not teach or suggest all the claim limitations for neither reference shows a probe that deposits a sensor to a preferred depth by pushing the probe to such a depth. Neither reference further teaches depositing the sensor within the bore by a withdrawal of the probe from the bore.

Bott v. Four Start Corp., 218 USPQ 358 (D.Ct, ED Mich 1983)(citing *Stevenson v. ITC*, 204 USPQ 276, 280 (CCPA 179)), "to be relevant, the area or art should be 'where one of ordinary skill in the art would be aware that similar problems exist.'" The Examiner has pointed to no teaching that evinces that problems attendant Waterman devices, i.e. placement of a probe through a pressurized container, are analogous or similar to deposition of a sensor to a prescribed depth within a bore.

The deficiencies noted above in regard to the primary Waterman '809 reference failing to teach or suggest the claimed invention are reiterated. As to Waterman '071, its addition does nothing to diminish or alter the deficiencies in the primary reference. Neither reference teaches a tip having a socket at a remote end that both pushes a sensor into a bore to a depth and releases the sensor at a predetermined depth as the remote tip socket is withdrawn from the bore. No bore has been designated by the Examiner in either reference. A withdrawal of a sensor-pushing socket from a bore, therefore, is not to be found or suggested in either of the references.

As to claim 2, the Waterman '071 reference does teach leads coming from *the probe holder* (emphasis added). However, that is not the limitation present in claim 2. Claim 2

recites an aligned axial passageway between the handle and the tip axial passageway such that the leads may progress from the remote tip end to an outer end of the handle passageway. Nothing in Waterman '071 teaches such a pathway. In fact, the handle 29 of Waterman '071 lacks any passageway therethrough. In additional fact, the apertured spherical valve closure 27 is interposed in Waterman'071 between the probe holder and the handle 27, rendering a progression of leads from the probe holder through a passageway in the handle impossible. One skilled in the art would not find it obvious to achieve the invention of claim 2 when both references by their structure prevent a routing of probe leads from a forward passage end back through a handle passageway. The rejection is accordingly traversed.

As to claim 12, the Examiner's reference to a bore in Waterman '071 is ambiguous. It is not clear as to what "tip" is being referenced in Waterman. The wall to the pipe 10 has an aperture therein that is not substantially the same as the length of probe 22. An access fitting 12 is welded to the pipe 10 and has an axial passageway. However, this is not a bore into which the probe is placed at a predetermined depth since probe 22 projects from the access fitting and into the pipe. Therefore, the length of probe 22 would not be substantially the same as the length of the access fitting 12. Applicant further maintains that neither reference is for the placement of a sensor to a predetermined depth within a bore and neither uses a tool tip that is detachable to allow for substantially matching the length of a tool tip to the bore into which the sensor is to be inserted. The Examiner has provided a combination of non-analogous references to the objectives and art to which the subject invention is directed. Neither reference contains any instruction that would direct one skilled in the art as to how to accomplish a sensor placement with a bore to a desired depth or a correlation between tip length and bore depth.

In rejecting claims under 35 U.S.C. Section 103, the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28

USPQ2d 1955, 1956 (Fed. Cir. 1993). In the instant case, no such *prima facie* case has been made. The rejection is based on a combination of references that share the same deficiencies in that neither teaches the limitations found in the rejected claims. The terminology in the claims has been ascribed to certain elements in the Waterman references, yet the elements do not meet the limitations found in the claims. No probe exists in Waterman for pushing a sensor to a prescribed depth within a bore; releasing and depositing the sensor by a removal of the probe from the bore. No probe in either Waterman reference has a length substantially equivalent to a bore depth into which the probe is to be inserted or co-aligned handle and probe axial bores that allow the routing of sensor leads from one end of the claimed device to the other. Waterman would be functionally incapable of use in the application to which the invention is directed.

III. Claims 1 through 13 are in compliance with the enabling requirement of 35 U.S.C. Section 112, first paragraph.

Claims 1 through 13 have been rejected under 35 U.S.C. Section 112, first paragraph, as failing to comply with the enablement requirement. This rejection is respectfully traversed for the following reasons. One skilled in the art would understand the configuration of the socket from the description in the specification of the forward end 32 of the tool tip 14 and as functionally described in the specification and sequentially illustrated in FIGS. 5, 6, and 7. The forward tip end, or socket 32, has a configuration that abuts and pushes the sensor along the bore path to its intended depth and, after reaching the desired depth, is freely withdrawn out of the bore, leaving the sensor at the prescribed depth within the bore. Thus, the claimed structure of "a sensor receiving socket" is fully shown in the drawings and described in the claims. One skilled in the art would clearly understand the structure in the specification referred to in the claims. One skilled in the art would further be enabled to make and use the invention from the specification and would readily understand the claimed configuration of the forward socket end of the tool tip.

CONCLUSION

In conclusion, the cited art on which rejection of the pending claims 1 through 13 is based do not collectively nor individually show:

a socket configured to push a sensor into a bore to a predetermined depth;

a socket configured to deposit the sensor at the predetermined depth as the remote tip socket is withdrawn from the bore (claims 1, 10 and claims dependent therefrom);

a handle that includes an axial passageway in axial alignment with the tip axial passageway for receiving sensor leads through the aligned passageways (claim 2);

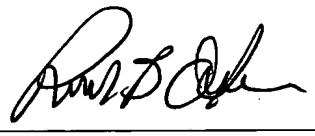
a detachable tip (claim 3) coupled to handle having a T-shaped gripping portion (claim 4);

an observation window spaced a predetermined distance from the remote tip end, the window having a transverse orientation with the axial passageway and positioned to allow visual communication with the tip passageway and sensor leads disposed from the sensor along the tip axial passageway (claims 5 and 11);

an axial slit in communication with the tip axial passageway.(claims 6, 13) sized substantially equal to the depth of the bore (claims 7, 12).

Reconsideration of the rejection of such claims and an allowance of all pending claims 1 through 13 is, therefore, respectfully requested.

Respectfully submitted,



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CLAIMS APPENDIX

CLAIMS

1. A tool for the insertion and release of a sensor to a predetermined depth within a bore, comprising:

a handle at a first tool end;

an elongate tool tip affixed to the handle at an opposite tool end, the tip having an axial passageway extending to a remote tip end;

the remote tip end having a sensor receiving socket in communication with the tip axial passageway, the socket being configured to push the sensor into the bore to the predetermined depth and release the sensor at the predetermined depth as the remote tip socket is withdrawn from the bore.

2. A tool according to claim 1, wherein the handle includes an axial passageway in axial alignment with the tip axial passageway, the aligned handle and tip passageways being dimensioned to receive sensor leads there through from the remote tip end to an outer end of the handle passageway.

3. A tool according to claim 1 wherein the tip is detachable from the handle.

4. A tool according to claim 1 wherein the handle includes a substantially T-shaped gripping portion.

5. A tool according to claim 1 wherein the tip includes an observation window spaced a predetermined distance from the remote tip end, the observation window having a transverse orientation with the axial passageway, and the window positioned_allowing visual communication with the tip passageway and sensor leads disposed from the sensor along the tip axial passageway.

6. A tool according to claim 5 wherein the tip further comprises an axial slit communicating with the tip passageway and extending between the tip end and the observation window.

7. A tool according to claim 1, wherein the length of the tip is substantially equal the depth of the bore.

8. A tool according to claim 1, wherein the handle is substantially T-shaped.

9. A tool according to claim 1, wherein the tool tip is an elongate roll pin having opposite slits extending in to the tip passageway.

10. A tool for the insertion and release of a sensor to a predetermined depth within a bore, comprising:

a handle at a first tool end;

an elongate tool tip extending from the handle to a remote tip end;

an axial passageway extending through the tip and handle to the first tool end; and

a sensor receiving socket at the tip remote end in communication with the axial passageway, the socket being configured to push the sensor into the bore to the predetermined depth and release the sensor at the predetermined depth as the remote tip socket is withdrawn from the bore.

11. A tool according to claim 10, wherein the tip includes an observation window positioned between the tip remote end and the handle in transverse orientation with the axial passageway, the window positioned to allow visual communication with the axial passageway and sensor leads extending from the sensor along the axial passageway.

12. A tool according to claim 11, wherein the length of the tip is substantially equal the depth of the bore.

13. A tool according to claim 12, wherein the tip is formed as a roll pin having opposite axial slits extending in to the tip passageway and extending between the remote tip end and the observation window.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None